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| 09/492, 133 | 01/27/00 | POLLIN | R 25541.010600 |

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EXAMINER

KALINOWSKI, A

ART UNIT

PAPER NUMBER

2166

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07/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|------------------------------|-----------------------------------------|-------------------------------|
| Office Action Summary | Application No. 09/492,133 | Applicant(s) Pollin |
| | Examiner Alexander Kalinowski | Art Unit 2166 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Jan 27, 2000
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

| | |
|------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 20) <input type="checkbox"/> Other: _____ |

Art Unit: 2166

DETAILED ACTION

1. Claim 26 is presented for examination . Of claims 1-25 originally filed in 1/27/2000, claims 1-25 were canceled and claim 26 was added by preliminary amendment filed on 1/27/2000.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 1 been renumbered to claim 26.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2166

4. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 5,504,677. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim in the instant application is broader than the '677 patent.

With respect to claim 1, the '677 patent discloses an automated system for generating a plurality of authorized drafts on financial accounts belonging to a plurality of payers, in payment of debts to a payee (see claim 3, col. 18, lines 6-9), comprising:

input means for performing an electronic information input process wherein a system operator contemporaneously enters information sufficient to identify a new payer previously unknown to the system and information specifying a draft to be generated on an account of that payer, said information including a financial institution identification number, payor account identifier, and an amount to be drafted from said payer's account (claim 3, col. 18, lines 10-16);
an institutional database comprising financial institution identification information (claim 3, col. 18, lines 17-18);

institution verification means associated with said input means for receiving said financial institution identification number and comparing said financial institution identification number to entries in said institutional database, wherein when said financial institution is found in the institutional database, the institution verification means retrieves identifying information about the institution and verifies the accuracy of said financial institution identification number, and wherein

Art Unit: 2166

when said financial institution is not found in the institutional database, an error indication is generated (claim 3, col. 18, lines 1-18).

The ‘677 patent does not explicitly disclose output means connected to said input means for receiving said information specifying a draft and generating in electronic information form a copy of said draft.

However, the ‘677 patent does disclose output means connected to said input means for receiving said information specifying a draft and generating in a paper copy of said draft (see claim 3, lines 41-46). Moreover, claim 3 of the ‘677 discloses that the output means is connected to the processing means for generating the paper copy. This implies that an electronic copy of the paper copy is generated and stored in electronic form in the processing means before the system generates the paper copy. Otherwise, the system would be unable function as disclosed in the ‘677 patent in order to generate the paper copy. It would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to include output means connected to said input means for receiving said information specifying a draft and generating in electronic information form a copy of said draft within the ‘677 patent for the motivation stated above.

5. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-80 of U.S. Patent No. 5,727,249. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application is broader than the claims in the ‘249 patent.

Art Unit: 2166

With respect to claim 1, the '249 patent discloses an automated system for generating a plurality of authorized drafts on financial accounts belonging to a plurality of payers, in payment of debts to a payee (see claim 41), comprising :

input means for performing an electronic information input process wherein a system operator contemporaneously enters information sufficient to identify a new payer previously unknown to the system and information specifying a draft to be generated on an account of that payer, said information including a financial institution identification number, payor account identifier, and an amount to be drafted from said payer's account (see claim 41);

an institutional database comprising financial institution identification information (see claim 41);

institution verification means associated with said input means for receiving said financial institution identification number and comparing said financial institution identification number to entries in said institutional database, wherein when said financial institution is found in the institutional database, the institution verification means retrieves identifying information about the institution and verifies the accuracy of said financial institution identification number, and wherein when said financial institution is not found in the institutional database, an error indication is generated (see claim 41).

The '249 patent does not explicitly disclose output means connected to said input means for receiving said information specifying a draft and generating in electronic information form a copy of said draft.

Art Unit: 2166

However, the '249 patent does disclose output means connected to said input means for receiving said information specifying a draft and generating in a paper copy of said draft (see claim 41). Moreover, claim 41 of the '249 discloses that the output means is connected to the processing means for generating the paper copy. This implies that an electronic copy of the paper copy is generated and stored in electronic form in the processing means before the system generates the paper copy. Otherwise, the system would be unable function as disclosed in the '249 patent in order to generate the paper copy. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include output means connected to said input means for receiving said information specifying a draft and generating in electronic information form a copy of said draft within the '249 patent for the motivation stated above.

6. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-80 of U.S. Patent No. 6,041,315. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim in the instant application is directed to the same claimed invention as the '315 patent.

With respect to claim 1, the '315 patent discloses an automated system for generating a plurality of authorized drafts on financial accounts belonging to a plurality of payers, in payment of debts to a payee (see claim 10), comprising:

input means for performing an electronic information input process wherein a system operator contemporaneously enters information sufficient to identify a new payer previously

Art Unit: 2166

unknown to the system and information specifying a draft to be generated on an account of that payer, said information including a financial institution identification number, payor account identifier, and an amount to be drafted from said payer's account (see claim 10);

an institutional database comprising financial institution identification information; institution verification means associated with said input means for receiving said financial institution identification number and comparing said financial institution identification number to entries in said institutional database, wherein when said financial institution is found in the institutional database, the institution verification means retrieves identifying information about the institution and verifies the accuracy of said financial institution identification number, and wherein when said financial institution is not found in the institutional database, an error indication is generated (see claim 10).

The '315 patent does not explicitly disclose output means connected to said input means for receiving said information specifying a draft and generating in electronic form a copy of said draft.

However, the '315 patent does disclose output means connected to said input means for receiving said information specifying a draft and generating in a paper copy of said draft (see claim 10). Moreover, claim 10 of the '315 discloses that the output means is connected to the processing means for generating the paper copy. This implies that an electronic copy of the paper copy is generated and stored in electronic form in the processing means before the system generates the paper copy. Otherwise, the system would be unable function as disclosed in the '315

Art Unit: 2166

patent in order to generate the paper copy. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include output means connected to said input means for receiving said information specifying a draft and generating in electronic information form a copy of said draft within the '315 patent for the motivation stated above.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

With respect to claim 1, the Fickenschur, Lisa, "Autoscribe Wins Patent for Phone Payment System Series: 15" reference (hereinafter Fickenschur) discloses an automated system (i.e. Auto-Pay) for generating authorized drafts (i.e. checks) belonging to a plurality of payers (i.e. consumers) in payment of debts to a payee (i.e. allows consumers to pay for goods and services over the phone using their checking accounts)(see page 1). Fickenschur further discloses that consumers authorize the payments verbally by providing the checking account number and other check information (see page 2). The payee then reproduces and deposits the check (see page 2). The product appears to be subject matter of the claimed invention that is disclosed by Pat. No.

Art Unit: 2166

5,504,677. Furthermore, the Examiner notes that Pat. No. 5,504,677 makes reference to the Auto-Pay product (see Fig. 3 - Fig. 7).

Although the Fickenschur reference does not qualify as prior art based on its publication date (June 17, 1994), the reference discloses that the Autoscribe Co. was marketing the Auto-Pay product for three years (see page 1). Therefore, it appears that the product was on sale for three years prior to the publication date of the Fickenschur reference, namely, on sale since June 17, 1991. The product was on sale more than 1 year prior to the claimed priority date of the instant application (the filing date of Pat. No. 6,041,315, namely June 19, 1997) and more than 1 year prior to the oldest priority that the Applicant can claim based on the declaration filed by Applicant (the filing date of the 5,504,677, namely, October, 15, 1992). The Examiner notes that such activity constitutes an on sale bar to the claimed invention.

9. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: the Examiner requests that Applicant provide all relevant information with respect to the Auto-Pay product that is referenced by the Fickenschur reference including any marketing bulletins or brochures that were published by the Autoscribe company.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Art Unit: 2166

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Pat. No. 5,652,786 discloses a telepay system for processing payment transactions.
- b. Pat. No. 5,873,072 discloses an automated system by which a consumer instructs a service provider by telephone to pay certain bills.
- c. "Telephone-check Patent" discloses a computer based system that permits creation of personal checks for consumers from remote sites.
- d. "AmEx, AT&T, and Prodigy Eye Bill-Payment Market Series:2" discloses electronic bill payment services offered to customers regardless of the institution where they do their banking.
- e. "Back Offices Pose Problems for Bill-Payment Services" discloses electronic bill payment services offered to customers where electronic media is created from telephone bill paying and is sent or transmitted directly to the biller.
- f. "Princeton Telecom Addresses Problems of On-Line Bill Payment" discloses printing individualized checks on behalf of consumers to be used for consumer payments.

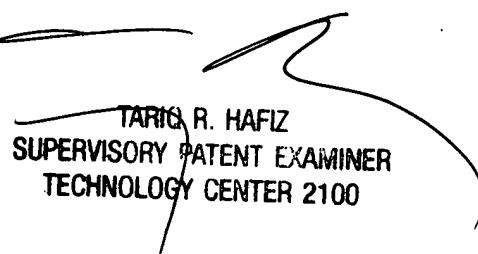
Art Unit: 2166

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 8:30 AM to 6:00 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax telephone number for this group is (703) 305-0040.

Alexander Kalinowski *AK*

6/30/2001


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